

REMARKS

Applicant respectfully requests reconsideration of the instant application on the basis of originally presented Claim 16 through 19. Claim 16 is the main claim and the remaining claims are directly or indirectly dependent upon that one.

The Examiner has rejected the claims as being unpatentable over U.S. Patent No. 5,493,111 by Wheeler *et al.* (*Wheeler*) in view of U.S. Patent No. 5,338,927 by de Groot *et al.* (*de Groot*). It is believed that Claims 16 to 19 are clearly distinguishable over these two references for the reasons that will be set forth.

Restriction Requirement

Applicant has canceled claims 27 through 29, without prejudice, and elects to proceed with claims 16 through 19 (Species I) in this application.

35 U.S.C. § 102(b) Grounds for Rejection

The Examiner has principally rejected the claims as being anticipated by *Wheeler*. It is believed that Claims 16 to 19 are clearly distinguishable over this *Wheeler* reference for the reasons that will be set forth.

The *Wheeler* patent shows an image intensifier tube or photomultiplier having a "brazed flange member 52" that effects the sealing engagement between the window member 16 and the base member 50. *Wheeler* goes on to further describe the seal 52 as follows:

"The window 16 is sealed into flange 52 with indium or similar seal material 52'. Flange member 52 is brazed onto the housing member 50 at step portion 72." (Col. 7, line 65 to col. 8, line 1)

Independent Claim 16 recites the following elements, the most pertinent to this discussion being presented in bold type for the convenience of the Examiner:

A method of making an image intensifier tube, said method including the steps of:

- providing an annular tube body;**
- providing a microchannel plate disposed within said tube body;**
- providing an electrical contact structure between said tube body and said microchannel plate;**
- providing a yieldably deformable and axially-variable sealing structure sealingly uniting the tube body with a window member, said window member carrying a photocathode; and**
- yielding said axially-variable sealing structure while maintaining a selected fine-dimension spacing between the photocathode and microchannel plate.**

Since such **yieldably deformable and axially-variable sealing structure** of the Applicant's invention as claimed is nowhere disclosed nor suggested by *Wheeler*, Applicant suggests that the claimed structure of the present invention is neither identical to nor disclosed by the *Wheeler* device. Therefore, *Wheeler* cannot anticipate the present claimed invention.

Moreover, the allegedly prior art devices lack the functional characteristics of the claimed structure in the method claim in the present application. The sealing structure of the cited device functions to "provide a highly conductive heat transfer path to the environment." *Wheeler*, Col. 9, lines 30-33.

Finally, since 1902 the Supreme Court has held that a process patent is not anticipated by a prior apparatus capable of use in practicing the process where the apparatus was not so actually used. Carnegie Steel Co. V. Cambria Iron Co., 185 U.S. 403, 22 S. Ct. 698 (1902).

"A process patent, . . . , is not anticipated by a mechanism which might with slight alterations have been adapted to carry to that process, unless, at least, such use of it would have occurred to one whose duty it was to make practical use of the mechanism described. In other words, a process patent can only be anticipated by

a prior device of like construction and capable of performing the same function; but it is otherwise with a process patent." 185 U.S. at 424.

Even if the *Wheeler* patent incidentally showed a similar arrangement of parts, if that arrangement is neither claimed nor designed to perform the function of the present invention, the *Wheeler* patent can not act as an anticipation.

35 U.S.C. § 103 Grounds for Rejection

The Examiner rejected Claims 17-18 under 35 U.S.C. § 103(a) as being unpatentable over *Wheeler* in view of *de Groot*. Applicant respectfully traverses these rejections for the reasons discussed below.

de Groot teaches an image intensifier tube having "glass beads" as shims 25 between the primary screen 19 and the input face 8.

"In the exemplary embodiment shown in FIG. 2, where the shims 25 are constituted by beads, these beads may be fixedly joined to the input face 8 of the slab 7 of microchannels by bonding." *de Groot*, Col. 5, lines 63-66.

Applicant's invention is directed toward an axially variable yielding sealing structure and maintaining a selected fine-dimension spacing between the photocathode and the microchannel plate. Nowhere does *de Groot* teach that any of seals or spacers of the image intensifier components are deformable. Rather, *de Groot* teaches that the primary screen 19 is the component that is "deformable." *de Groot*, Col. 6, lines 26-31.

Moreover, since the beads 25 of *de Groot* are joined to the MCP 7, such are not "formed integrally with said photocathode" as is claimed in claim 18 of the instant application.

By the structure included in the method steps Applicant is able to achieve the advantages which have hitherto not been achievable through any adaptation of the prior art. It is therefore believed to be clear that the particular structure of Applicant is extremely important and is not a mere matter of design.

It is improper to use hindsight having read the Applicant's disclosure to "pick and choose" among isolated prior art references to disparage the claimed invention. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Even where an invention is, as a whole, fully disclosed by a combination of prior art elements, such elements cannot be combined to defeat a patent as obvious unless the art teaches or suggests the desirability of making the combination. ASC Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 221 U.S.P.Q. 929 (Fed. Cir. 1984). Thus, the mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F.2d 1260, U.S.P.Q.2d 1780 (Fed. Cir. 1992). Finally, it is the invention as a whole that is important. Focusing on the obviousness of substitutions and differences, instead of on the invention as a whole, is a legally improper way to simplify the often difficult determination of obviousness. Gillette Co. v. S. C Johnson & Son, Inc., 919 F. 2d 720, 16 U.S.P.Q. 1923 (Fed. Cir. 1990).

The combination of *Wheeler* with *de Groot* fails to teach or suggest these claim elements.

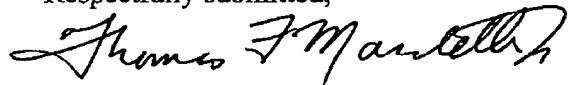
Further dependent Claims 17-18 that depend from independent Claim 16 are also not made obvious by *Wheeler* in view of *de Groot* because they include the limitations of Claim 16 and add additional elements that further distinguish the art. Therefore, Applicant respectfully requests that Claims 16-19 be allowed.

Conclusion

Applicant has now made an earnest attempt to place this case in condition for allowance. In light of the amendments and remarks set forth above, Applicant respectfully requests reconsideration and allowance of Claims 16-19.

If there are matters which can be discussed by telephone to further the prosecution of this Application, Applicant invites the Examiner to call the attorney at the number listed below at the Examiner's convenience.

Respectfully submitted,



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